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OFFICE OF PETITIONS

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In re Application of
Burgess, Bertrand, Ciancaglini, Haff, Lannert, Levitt, Nichols
Poon, J. Smith, K. Smith, Zabloudil, Walsh, Willow, and Willis
Application No. 09/887,188
Filed: June 22, 2001
Attorney Docket No. 05222.00141
For: SYSTEM, METHOD AND ARTICLE OF
MANUFACTURE FOR A SIMULATION ENABLES RETAIL
MANAGEMENT TUTORIAL SYSTEM

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed March 15, 2002.

The petition under 37 CFR 1.47(a) is **dismissed**.

Any request for reconsideration under this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)". Failure to respond will result in abandonment of the application. Extensions of time are available and will be governed by 37 CFR 1.136(a).

The above-cited application was filed without a properly executed oath or declaration. In response, the Office mailed a "Notice to File Missing Part of Non-Provisional Application" (the "Notice") on August 15, 2001. The Notice set forth an extendable period for reply of two months from its mailing date. On March 15, 2002, in response to the Notice, petitioner filed the instant petition, a request for an extension of time within the fifth month, declarations for all inventors, except inventor Haff, and paid the outstanding surcharge of \$130.00.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and,
- (4) a statement of the last known address of the non-signing inventor.

Petitioner lacks item (1) as set forth above.

Petitioner suggests that a declaration executed by inventor Haff in a prior application PCT/US99/02740 which claims priority to 09/219,201 of which the above cited application is a continuation, should be entered as the required declaration for inventor Haff in the present application. Petitioner further states that the specification of the prior application is identical to that of the present application and contains at least the same claims as the prior application suggesting that inventor Haff's receipt and review of the prior application should suffice as her receipt and review of the present application.

Petitioner's attention is called to 37 CFR 1.63(d)(1)(ii) which states, in pertinent part, that "[a] newly executed oath or declaration is not required under 1.51(b)(2) and 1.53(f) in a continuation or divisional application, provided that . . . the continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application." In instant case, the continuation application was filed by more than the inventors named in the prior application. Consequently, a new declaration is required for all the named inventors in the continuation application.

As to item (1) above, the fact that inventor Haff received the prior application will not satisfy the requirement of 37 CFR 1.47 the complete application papers (specification, claims, drawings, and declaration) be presented to the nonsigning inventor. In order for a refusal by the nonsigning inventor to be accepted, an effort must be made to present the nonsigning inventor with present application because, by executing the declaration, the nonsigning inventor is representing that he or she reviewed the application as identified on the declaration. Accordingly, inventor's Haff receipt of the prior application will not serve to satisfy the requirement of 37 CFR 1.47 that a complete copy of the application be sent to the last known address of the nonsigning inventor.

As to the information provided in the instant petition, petitioner only indicates that the declaration, power of attorney, and assignment were sent to inventor Haff, not the complete application papers as required. Although inventor Haff may have provided an express refusal, the refusal cannot be accepted because it cannot be said that inventor Haff had full knowledge of what she was refusing to sign because she was not presented with a complete copy of the application papers. In order for the refusal of inventor Haff to be accepted, inventor Haff must be presented with a complete copy of the application papers.

It is noted that the alleged express refusal of inventor was communicated by a statement authored by Charles L. Miller, however; the express refusal was made to Ms. Monique Chan. *The Manual of Patent Examining Procedure*, Section 409.03(d) provides, in pertinent part, that:

[w]here a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Accordingly, any renewed petition must be accompanied by a statement as offered by Ms. Monique Chan as to the circumstances surrounding the inventors Haff's express refusal to join the application.

Deposit Account 19-0733 will be assessed \$130.00 for the petition fee. See 37 CFR 1.17(h).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, DC 20231

By FAX: (703) 308-6919
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 South Clark Place
 Arlington, Virginia

Telephone inquiries should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.


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